

P21670.A03



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Takashi MORITA

Group Art Unit: 2872

Serial No. : 10/098,544

Examiner: J. Phan

Filed : March 18, 2002

For : SCANNER HAVING A LIGHT BEAM INCIDENT POSITION
ADJUSTING DEVICE

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Election of Species Requirement of June 4, 2003, in which a one-month shortened statutory period for response was set to expire on July 5, 2003 (July 4, 2003 being a National Holiday, and July 5, 2003 and July 6, 2003 falling on a weekend), Applicant hereby elects the species of Group I, with traverse, for the reasons set forth hereinbelow. Claim 5 is considered to be readable on the invention of Group I.

In the above-noted Election of Species Requirement, the Examiner required election of species based on an assertion that the "application contains claims directed to... patentably distinct species of the claimed invention". The Examiner asserted that Species I corresponds to the structure of Fig. 2; Species II corresponds to the structure of Fig. 9; Species III

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corresponds to the structure of Fig. 10; and Species IV corresponds to the structure of Fig. 11. The Examiner indicated that no claim is generic.

Applicant respectfully traverses the Election Requirement. Applicant respectfully requests that all of the species defined in claims 1-6 be examined in the instant application, pursuant to the guidelines set forth in the MPEP at, e.g., section 803, 806 and 809.

In particular, the MPEP sets forth at section 803, "two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent... or distinct as claimed; and (B) There must be a serious burden on the examiner if restriction is required" (emphasis added). See MPEP 803 - CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS. Both of these are explicitly related, by section citations, to election of species requirements.

Initially, with respect to the later requirement (i.e., "(B)'), Applicant notes that the outstanding Election of Species Requirement does not so much as attempt to establish *prima facie* a serious burden by, for example, "separate classification, separate status in the art, or a different field of search", as required in the MPEP. See MPEP 803 - GUIDELINES. Accordingly, Applicant respectfully submits that the above-noted Election of Species Requirement has not set forth an adequate or proper basis for requiring an Election of Species.

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Further, Applicant notes that for a Requirement for Election of Species to be proper, there must be an indication that, for example, the features of claims 1 or 2 are not in any way "capable of use together" (i.e. are mutually exclusive). See MPEP 806.04. However, Applicant respectfully submits that the features of the invention recited in claim 5 could be used with the features of either claim 1 or claims 2-4, at least because the features of claim 5 do not mutually exclude the features of claim 1 or claims 2-4. Accordingly, Applicant respectfully submits that the Election of Species Requirement is not supported under the requirement of MPEP 803 for a showing of serious burden, or under the definition of MPEP 806.04 of "Independent Inventions". Until such a serious burden and a showing of the independence (mutually exclusive species) of the claimed species is shown, Applicant respectfully asserts that the above-noted Election of Species requirement is improper.

That is, the Examiner is respectfully requested to reconsider the requirement and find that the features of the species are not mutually exclusive and that there would not appear to be a "serious burden" on the Patent and Trademark Office in examining claims directed to non-elected species.

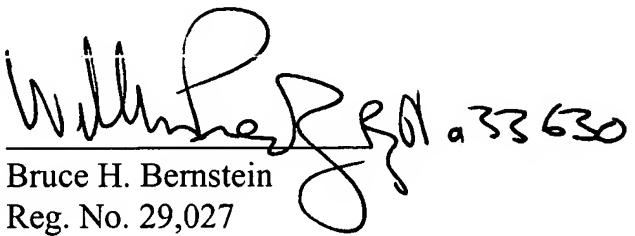
For the reasons noted above, and consistent with office policy as set forth in MPEP 803, 806 and 809, Applicant respectfully requests that the Examiner reconsider and withdraw the Election of Species Requirement. For each of the reasons noted above, Applicant

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submits that the Requirement for Election of Species in this application is improper and it
is respectfully requested that it be reconsidered and withdrawn.

Should the Examiner have any questions, the Examiner is invited to contact the
undersigned at the below-listed telephone number.

Respectfully submitted,
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July 7, 2003
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